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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 601

THE GOODYEAR TIRE & RUBBER COMPANY, ET AL.,
Petitioners

v.

COMMISSIONER OF PATENTS, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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THE GOODYEAR TIRE & RUBBER COMPANY, ET AL.,
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COMMISSIONER OF PATENTS, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

Petitioners pray that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit, entered in the above-entitled case on June 24, 1965.[1]

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[1] Petitioners are: The Goodyear Tire & Rubber Company, and Thomas H. Rogers, Jr., Newell R. Bender and Theodore B. Burkholder, assignors to The Goodyear Tire & Rubber Company.

I. CITATIONS TO OPINIONS BELOW

The Opinions of the Patent Office Board of Appeals (R. 330, 342) are unreported and are printed in Appendix C1 hereto, infra, pages 8a-12a, inclusive.

The Opinion of the District Court (R. 12), printed in Appendix C2 hereto, infra, pages 13a-17a, inclusive, is reported in 224 F. Supp. 781. The Opinion of the Court of Appeals, printed in Appendix C3 hereto, infra, pages 18a-20a, inclusive, is not yet reported.

II. JURISDICTION

The Judgment of the Court of Appeals for the District of Columbia Circuit was entered on June 24, 1965 (R. 472); Appendix C3, page 18a, infra. The jurisdiction of this Court is invoked under 28 United States Code 1254 (1).

III. QUESTIONS PRESENTED

Two questions are presented herein, the second of which is similar to a question presently before the Court in a case in which a Petition for Writ of Certiorari has been granted.

The first question presented in this Petition is:

1. Is it a denial of due process for the Courts of the District of Columbia Circuit to impose upon an applicant for patent the virtually insurmountable burden of showing, in a *de novo* civil action against the Commissioner of Patents in the United States District Court for the District of Columbia, under 35 U.S.C. 145, that the Patent Office, on the evidence which was before it, was *clearly erroneous* or *acted without rational basis* in refusing to issue the patent, particularly

where such burden is both inconsistent with and greater than the burden placed on the applicant in seeking judicial review of such refusal in the Court of Customs and Patent Appeals, as provided in 35 U.S.C. 141 to 144, inclusive, where the record is limited to the evidence produced before the Patent Office and the decision is confined to the points set forth in the reasons of appeal to that Court?

The second question[2] presented in this Petition is:

2. May an "abandoned"[3] patent application of one party be used as evidence of what the general fund of knowledge or "prior art" was during the time the "abandoned" application was "kept in confidence" and "preserved in secrecy" by the Patent Office pursuant to statute and Patent Office rules, to refuse a patent to another party on the ground of "obviousness" under 35 U.S.C. 103 when the application for patent was filed by the latter before such "abandoned" application became available for public inspection?

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[2] A question similar to Question 2 of the present Petition is presently pending before the Court in *Hazeltine Research Inc. and Robert Regis*, Petitioners v. *David L. Ladd*, Commissioner of Patents, Respondent, October Term 1965, No. 57 (October Term, 1964, No. 919), Petition filed Feb. 18, 1965, Petition granted April 5, 1965, 85 S. Ct. 1108. In that case the reference relied upon was a "co-pending patent", whereas the present question relates to the use of an "abandoned" application as a reference.

[3] An "abandoned" patent application is an application which never became an issued patent because either: (1) the applicant failed to prosecute the application as required by 35 U.S.C. 133 and Patent Rule 135 or to pay the final fee required by 35 U.S.C. 151 and Patent Rules 314 and 316; or (2) the applicant filed an express abandonment of the application under Patent Rule 138.

IV. STATUTES INVOLVED

The statutes primarily involved are Sections 102, 103, 122 and 141 to 145, inclusive, of the Patent Act of July 19, 1952, C. 950, Sec. 1, 66 Stat. 792, 35 United States Code 102, 103, 122 and 141-145, inclusive. They are printed in Appendix A, infra, pages 1a-4a, inclusive.

V. PATENT OFFICE RULES INVOLVED

The Patent Office Rules primarily involved are Rules 14, 108, 135, 137, and 138. They are printed in Appendix B, infra, pages 4a-7a inclusive.

VI. STATEMENT

A. The Invention

An application for patent, designated as Rogers et al. application Serial No. 514,106, was filed by petitioners in the United States Patent Office on June 8, 1955 (R. 267-346).

Petitioners' invention claimed relates to a unique process for the manufacture of cellular, flexible polyurethane foam, a commercially important synthetic plastic material used for many industrial purposes. (R. 376-384, inclusive).

Petitioners discovered how to solve the problems of "fissuring" as well as control over cell size and uniformity of the synthetic plastic foam material. By utilizing petitioner's process it is possible to produce as much as 70% first class material whereas only 30% to 40% first class material could be produced prior to the discovery of petitioners' process. (R. 246)

B. Patent Office Refusal to Issue Patent

The application was examined and, on March 15, 1956, was first rejected on Newell Patent 2,676,157, issued April 20, 1954 (R. 286). An amendment was filed and reconsideration of the rejection was requested on behalf of petitioners on August 31, 1956 (R. 287-288).

About nine months later (on May 17, 1957) the Examiner responded to the amendment, withdrew his rejection on Newell Patent 2,676,157, supra, but, instead, rejected petitioners' application on Hoppe et al. Patent 2,764,565 which had just issued on September 25, 1956 on an application filed August 8, 1955 (R. 289), which was a date *after* the filing date of petitioners' application.

Inasmuch as the Hoppe et al. patent was NOT a "co-pending patent"[4], as that term is used in *Alexander Milburn* v. *Davis Bournonville,* 270 U.S. 390, the effective date thereof was not early enough to constitute a reference against petitioners' application. The Examiner recognized that the application on which the *patent* issued to Hoppe et al. was filed too late to be a valid reference as a "co-pending" patent and thereupon switched reliance to an "abandoned" *application* of Hoppe et al., Serial No. 327,522, filed December 23, 1952 (R. 289), which was referred to in the aforementioned patent, contending that the effective date of the "co-pending" *patent* as a reference was retroactive to the filing date of the "abandoned" *application.*

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[4] A "co-pending patent", as defined in the petition of Haseltine (October, 1965 Term, No. 57), is one *issued after* the filing date of a patent application against which it is cited, but based upon an application *filed before* the patent application or patent in issue.

The "abandoned" application of Hoppe et al. merely disclosed and claimed the concept of making rigid, semi-rigid or elastic polyurethane plastics by *introducing one or more of the reactants into the mixture by high frequency intermittent injection of the reactant.* Nothing was said in the "abandoned" application about *maintaining* pressure on the reaction mixture while thoroughly blending the reactants, or that cell diameter could be *increased* by mixing under pressure of 0.5 to 60 pounds per square inch.

The "co-pending" patent did, *later,* refer to maintaining a pressure of that magnitude during the thorough mixing of the reactants. The filing date of that application, however, was *after* the filing date of petitioners' application.

The Examiner contended that some pressure inherently existed throughout the mixing of the materials after the high pressure, intermittent, high frequency injection of one or more of the components. This was shown to the Trial Court to be erroneous, as a matter of scientific principle, since the components were not thoroughly mixed when they reached the mixing chamber and since the mixing chamber was open to the atmosphere the mixed components flowed out of the chamber by gravity rather than being under superatmospheric pressure in the chamber.

Since the portions of the Hoppe et al. *patent* relied upon by the Examiner, column 6, lines 35-41 (R. 459), did not appear anywhere in the "abandoned" application of Hoppe et al. (R. 347-367), he took the position that the invention claimed by petitioners would have been "obvious" to one having ordinary skill in the art *at the time the "abandoned" application was filed.*

In an amendment filed November 12, 1957 (R. 291) the lack of foundation for the Examiner's rejection was pointed out by petitioners.

The Examiner again, on April 29, 1958, rejected the petitioners' application as "unpatentable" over the Hoppe et al. *patent* (R. 293), citing page 6, lines 17-19[5] of the "abandoned" *application*. However, even that passage did not appear in the issued Hoppe et al. *patent* (Compare: R. 454-464). The Examiner's action concluded with the statement that "The instant claims lack invention over Hoppe et al." (R. 294).

Petitioners filed an appeal to the Patent Office Board of Appeals on October 24, 1958 seeking reversal of the Examiner's refusal to issue a patent to petitioners (R. 294).

The Board of Appeals affirmed the Examiner in a decision rendered November 13, 1961, stating that "the appealed claims define nothing patentable over the cited reference", the "reference" being the Hoppe et al. *patent* (R. 330-332). Reconsideration of the Board's decision was requested (R. 333-342), but the Board refused to change its decision (R. 342-343).

C. Remedy Sought in District Court

A civil action was brought against the Commissioner of Patents pursuant to 35 U.S.C. 145 on February 28, 1962, petitioners having elected to obtain relief from the action of the Patent Office by way of a trial de novo, as provided in that section of the Patent Act of 1952 (R. 5-10), rather than taking an "appeal" to the Court of Customs and Patent Appeals pursuant

[5] This passage corresponds to the first three lines of the first full paragraph, R. 351.

to 35 U.S.C. 141 to 144, inclusive. This case was tried by the District Court for the District of Columbia in May, 1963 (R. 3).

The District Court, after hearing testimony in open court, receiving documentary evidence which was not before the Patent Office and witnessing a demonstration of the invention, dismissed the Complaint on December 23, 1963, holding that "it is apparent that at least two sets of inventors made the same invention at approximately the same time" and that "This fact, coupled with the fact that the evidence did not show that plaintiffs' invention solved a long-standing problem in the art * * * tends to negate plaintiffs' contention that their invention was an unobvious advance in the art." (R. 15).

The Court went on to say:

> "Of course it should also be noted that during the trial, several expert witnesses testified that plaintiffs' invention would not have been obvious to them in view of the disclosure in the Hoppe et al. application. However, this opinion evidence must be balanced and tested against the above-mentioned facts. Admittedly, this case is extremely close, but for the reasons given above, the Court cannot say that the tribunals of the Patent Office were *clearly erroneous* in holding that the claims in suit were unpatentable over the Hoppe et al. patent. (Emphasis petitioners)
>
> * * * *
>
> In view of what has hereinbefore set out, the Court holds that the decision of the Board of Appeals has not been shown to be in *clear error,* and that judgment should issue for the defendant and against the plaintiffs." (R. 16). (Emphasis petitioners)

With regard to the reliance of the Patent Office on the *abandoned* Hoppe et al. application to antedate petitioners' filing date, the District Court held:

> "The parties agree that only the disclosure brought forward from application Serial No. 327,522 is available as a reference since only that disclosure has a filing date earlier than the filing date of plaintiffs' application." (R. 13)[6]

Notwithstanding the fact that the statute under which judicial review was sought provides for a *trial de novo,* and the only issue to be decided by the Court was whether or not "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertaining", the District Court attached to the ruling of the Patent Office *a presumption of correctness which could be rebutted only by demon-*

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[6] This was before the decision of the United States Court of Customs and Patent Appeals handed down *In re Palmquist,* 51 CCPA 839; 319 F. 2d 547 (Decided June 28, 1963) became final and before decision *In re Foster* (Decided April 15, 1965), 343 F. 2d 980 (overruling Palmquist, supra, in part), in which a Petition for Writ of Certiorari is now pending before this Court under No. 347, October Term, 1965.

Had the Hoppe et al. patent *issued* before petitioners *filed* the application in suit, the *abandoned* Hoppe et al. application referred to in the issued patent might have been effective as of its filing date as a reference under Section 102 *if it completely disclosed the invention in suit* since it would then have been available to the public. Whether or not it is a proper reference under Section 103, even under those circumstances is within the scope of the question presented in In the Matter of *Foster,* supra.

strating that there was "clear error or lack of rational basis in that decision," citing *Abbott et al* v. *Coe,* 109 F. 2d 449 (CADC 1939) and *Schaefer* v. *Watson,* 288 F. 2d 144 (CADC 1961). (R. 14)

D. Appeal to Court of Appeals

Appeal was duly taken to the Court of Appeals for the District of Columbia Circuit on January 17, 1964 and was argued there on October 12, 1964. Eight months later, in a *Per Curiam* Opinion dated June 24, 1965, the Court of Appeals affirmed the Judgment of the District Court, stating:

> "The Patent Office held that this disclosure [of the *abandoned* Hoppe et al. application] would suggest the process of mixing the ingredients under pressure to one with ordinary skill in the art. Although some evidence at trial conflicted with this holding, the District Court agreed with the Patent Office, relying on its expertness and stating that obviousness was indicated by the facts that another inventor had discovered the process at about the same time as appellants did and that the problem was not of long standing in the art.[3]
>
> The Patent Office's expertness in determining technical questions such as obviousness requires affirmance of its judgments *unless they have no rational basis.*[3] Since the Patent Office's finding of obviousness is supported by the record, the District Court's judgment *is not clearly erroneous.*[4]" (R. 474) (Emphasis petitioners' and citations omitted)

VII. REASONS FOR GRANTING THE WRIT

Question 1. Due Process—Burden of Proof

The first question presented is an important question of law which the Supreme Court has not previously considered and involves a conflict and inconsist-

ency between the United States Court of Appeals for the District of Columbia Circuit and the United States Court of Customs and Patent Appeals as to the burden of proof required by the respective courts of an applicant for a patent to overcome the refusal of the Commissioner of Patents to issue the patent sought. The current importance of the question is eloquently illustrated by the article entitled "The Scope of Review of the Court of Customs and Patent Appeals: Time for a Change?" 33 George Washington University Law Review 955, April 1965.

The patent laws of the United States, beginning as early as 1793[7] have provided a remedy for the refusal of the government to issue a patent to one party where another party also claimed the right to the patent. The early statutes provided for the appointment of a Board to arbitrate the matter. Their decision or award was final as to the granting of the patent.

In 1836 there was a general revision of the patent laws which, among other things, gave the duty of issuing patents to a Commissioner. The remedy provided in that act for refusal of the Commissioner to issue a patent was by way of submission of the matter to a disinterested three-man Board of Examiners appointed by the Secretary of State, at least one of the Examiners, preferably, being knowledgeable or skilled in the art to which the invention pertained.[8] The Commissioner and the applicant were afforded "an oppor-

[7] Act of February 21, 1793; Chap. XI, Sec. 9—Appendix E, page 22a.

[8] Act of July 4, 1836; Chap. 357, Sec. 7; 5 Stat. 117—Appendix E, page 22a.

tunity of furnishing them with such facts and evidence as they may deem necessary to a just decision."

If, however, the Board of Examiners refused an application on the ground it would interfere with an unexpired patent, any interested party could have remedy by a "bill in equity" in a Court having cognizance thereof.[9] Whereas judicial review of the action of an administrative agency is normally by way of direct "appeal" to a Circuit Court of Appeals *on the record made in the agency, the remedy by way of a civil action against* the Commissioner to obtain a patent is unique in the administrative process.[10]

Thus, at least since 1836, the refusal of the Patent Office to issue a patent has been subject to review in proceedings in which new evidence could be introduced. Legislative histories of the early acts show that the *equitable* actions against the Commissioner of Patents have always been in the nature of new trials. The actions have often been characterized as trials *de novo*.

Shortly after the establishment of the Circuit Courts of Appeals in 1891, the law provided, as an alternative remedy for the refusal of the Commissioner to issue a patent, a direct "appeal" to the Circuit Court for the District of Columbia *on the record made in the Patent Office*. In 1929 the jurisdiction of such direct "appeals" was transferred to the Court of Customs

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[9] Act of July 4, 1836; Chap. CCCLVII, Sec. 16—Appendix E, page 25a.

[10] See West Publishing Company Chart. "The Judicial System of the United States", 1964 Revised Edition—Heading "Original Jurisdiction", "A. Civil Actions", "28" and pink "boxes" in upper right hand corner of chart.

Appeals and the name of that Court was changed to the Court of Customs and Patent Appeals.

While equity actions authorized by the patent laws have consistently been in the nature of new trials where new evidence could be introduced Courts having jurisdiction of such actions have attached varying degrees of presumptions of correctness to Patent Office decisions. In 1894[11], this Court had occasion to define the burden to be borne by a plaintiff in an *inter partes* action in equity in the Federal Court seeking to overturn an adverse decision in the Patent Office in an "interference" proceeding to which the Commissioner was not a party. In that case, the Court, having pointed out that the Patent Office had already determined the only question involved, namely: which of the contending parties was the prior inventor and, therefore, was entitled to receive the patent, stated:

> "* * * where the question decided in the Patent Office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction."

No decision of this Court nor any enactment of Congress has modified the rule laid down in *Morgan* v. *Daniels,* supra. Yet in 1939, a decision of the Court of Appeals for the District of Columbia Circuit in *Abbott* v. *Coe*[12], wherein an applicant was refused a patent over an earlier reference, applied a more strict

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[11] *Morgan* v. *Daniels,* 153 U.S. 120; 14 S. Ct. 772 (1894).

[12] 109 F. 2d 449.

burden of proof which requires an infinitely greater quantum of evidence to overcome the *ex parte* refusal of the Patent Office to issue a patent to an applicant.

Since *Abbott* v. *Coe,* supra, the Courts for the District of Columbia have demanded proof that the Patent Office *ex parte* refusal to issue the patent was at least "clearly erroneous" or lacks a "rational basis."

In deciding the present case, the Court of Appeals demanded the degree of proof set forth above, stating:

> "The Patent Office's expertness in determining technical questions such as obviousness requires affirmance of its judgments *unless they have no rational basis.*" (Emphasis petitioners')

In place of a burden of establishing his case "by testimony which in character and amount carries thorough conviction", as ruled by the Supreme Court in *Morgan* v. *Daniels,* supra, the District of Columbia Circuit now requires a plaintiff not only to show that the Patent Office decision complained of is *irrational* but that irrationality must be shown by more than a mere preponderance of the evidence. Petitioner is, therefore, saddled with an evidentiary burden which is virtually impossible to meet in practically all circumstances. Irrationality is seldom, if ever, the cause of erroneous decisions. Yet proof of irrationality by more than a mere preponderance of the evidence is now a prerequisite to reversal of the Patent Office, according to the United States Court of Appeals for the District of Columbia Circuit.[13] Requiring proof by evidence

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[13] By comparison such a burden is not even required in the various Circuit Courts of Appeals when they strike down *issued* patents which carry a statutory presumption of validity as well as an ordinary presumption of correctness in the issuance of the patent.

which carries "thorough conviction" that the action was irrational, is tantamount to requiring proof "beyond a reasonable doubt" that error has been committed by the refusal of the Patent Office to issue the patent sought.

This standard of proof binds the District Court to an affirmance of the Patent Office in virtually every case. As stated by Circuit Judge Danaher in his dissent in *Hendrix* v. *Ladd*, 301 F. 2d 527, 529 (CADC 1962):

> "The District Judge obviously felt bound by and relied upon Abbott v. Coe, as his opinion shows. We had made him its prisoner by the status we had accorded to a mere presumption."

Even though petitioners demonstrated to the trial court in the present case that the Patent Office was clearly in error, the court was, in the language of Judge Danaher, a prisoner of the dogma of *Abbott* v. *Coe* and was compelled to affirm where nothing more than the status of a mere presumption should have been accorded that decision.

Although Congress has seen fit, for nearly a century and a half, to provide a remedy for applicants who are dissatisfied with Patent Office decisions by permitting equitable actions against the Commissioner of Patents, the Court of Appeals for the District of Columbia Circuit in *Abbott* v. *Coe* effectively abolished this avenue of review by imposing on the aggrieved party a burden of proof equal to that required to obtain a conviction in a criminal action.

On the other hand, in the Court of Customs and Patent Appeals, where the review is by appeal *on the record made in the Patent Office,* the appellant merely

has the burden of convincing at least three of the five Judges of that Court that the applicant is entitled to receive the patent and that Court does not hesitate to substitute its own judgment for that of the Patent Office. It is apparent from a reading of the decisions of the Court of Customs and Patent Appeals that it accords almost no presumption of correctness to Patent Office decisions, freely substitutes its own opinion on issues of fact and even resolves doubts in favor of applicants. It has said so in so many words in some of its recent opinions, even going so far as to resolve doubts *in favor of* the appellants where the record is limited to that made before the Patent Office and the decision goes beyond the errors assigned in the reasons for appeal.[14]

Petitioner well realizes the reticence and distaste with which the Court of Appeals for the District of Columbia Circuit, as well as the District Court, approach and exercise their jurisdiction over cases arising out of the Patent Office under the statute. However, the Courts of this Circuit, being the only Courts before which cases of this type arise in the United States, should be cautious so as not to avoid by judicial construction the very function which the statute has conferred upon them.

The Courts of the District of Columbia, by applying the virtually insurmountable evidentiary tests of *Abbott* v. *Coe*, supra, have, in effect, overruled a statute of Congress and denied a statutory judicial remedy to every disappointed applicant for patent. This is a de-

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[14] See, for example, *In re Citron*, 251 F. 2d 619 (CCPA, 1958) and other cases cited in Appendix F, page 26a.

nial of due process of law which this Court should rectify.[15]

This leaves the applicant on the horns of a dilemma. He will have to choose between an appeal to the Court of Customs and Patent Appeals *on the record made before the Examiner* or be confronted with the virtually insurmountable burden of proving, by new and additional evidence, before the Courts of the District of Columbia that the Patent Office *acted without rational basis* in refusing to issue a patent. Since the applicant is required to show that the Patent Office acted *irrationally,* he is in effect denied the *de novo* equitable consideration to which he is entitled in the civil action, and is therefore denied the due process intended to be afforded as a remedy under 35 U.S.C. 145.

Congress has seen fit to give applicants for patent a *choice* of remedies when the Patent Office refuses to issue a patent. On the one hand, it provides for an appellate review, in the normal sense of the word, before the five-Judge Court of Customs and Patent Appeals solely on the record made in the Patent Office. 35 U.S.C. 141-144. It appears from 35 U.S.C. 142 and 144 that only those points as to which error is specifically assigned may be determined by that Court. On the other hand, Congress provided in 35 U.S.C. 145 for a civil action[16] in which the Court is authorized to

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[15] It should be noted, however, that such result is not condoned unanimously by the Court of Appeals as is evident from the dissent of Judge Danaher in Hendrix v. Ladd, supra. Prior to Abbott v. Coe, supra, Judge Edgerton, the author of the opinion in that case, had dissented when the Court of Appeals held against the Patent Office. See *Carbide & Carbon Chemicals Corp.* v. *Coe,* 102 F. 2d 236 (CADC 1938).

[16] The antecedent statute, RS 4915, enacted prior to the abolition of the distinction between actions at law and actions in equity, specified that the action against the Commissioner of Patents would be by way of a "bill in equity".

"adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, *as the facts in the case may appear*" (Emphasis petitioners'). In other words, Congress has conferred on the District Court for the District of Columbia the right to determine whether or not a patent should be granted. In so doing it is not limited to the evidence which was before the Patent Office, but may make such determination on the whole of the evidence produced at trial, regardless of the previous refusal of the Patent Office to issue a patent on the limited amount of evidence which was before the Examiner in the Patent Office.

It is contrary to statute and therefore denial of due process for the Courts of the District of Columbia Circuit to fail to exercise their statutory duty to determine the issue of patentability *de novo,* as required by 35 U.S.C. 145. We are not concerned, at the moment, with the duty of the Court of Customs and Patent Appeals to limit its consideration to matters of *reversible error* committed by the Patent Office or to argue that the burden imposed by that Court on applicants is too light. However, the anachronism which exists between the presumptions attached to the Patent Office findings by the tribunals having *de novo* jurisdiction to determine patentability and those attached by the Court having only *appellate* jurisdiction to consider alleged error in those findings should be resolved.

Question 2. Evidence—Prior Art

The second question presented herein, insofar as it revolves around the issue of what constitutes "prior" art is similar in some respects to the question pending

before the Court in *Hazeltine* v. *Ladd*, supra, certiorari granted April 5, 1965, 85 S. Ct. 1108. In that case, the Hazeltine patent application was refused on the ground of "obviousness" under 35 U.S.C. 103 on "prior art" consisting of a "co-pending patent" (i.e., a patent *issued after* the filing date of the Hazeltine application on an application *filed before* the Hazeltine application).

In the present case, however, petitioners' application for patent was refused on the same ground ("obviousness" under 35 U.S.C. 103) on a reference consisting of a *patent* which *issued after* the filing date of petitioners' application, but (contrary to the facts in Hazeltine) upon an *application* which was *filed after* petitioners' application was filed. In both the Hazeltine case and the present case the reference patent issued on an *application* which was "kept in confidence" and "preserved in secrecy" at the time the petitioners' applications were filed, but both were used as "art" under Section 103 to refuse the respective patents sought.[17]

The question presented herein differs from that presented in Hazeltine in that the reference relied on by the Examiner in the present case was an *abandoned application* which was filed before petitioners' application was filed, but which *never matured into a patent*

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[17] The question in *Foster* v. *United States* (October Term, 1965 No. 347) differs somewhat in that the reference in that case was a publication which was published *after* Foster *made his invention*, but published more than a year *before* Foster *filed his application* for patent.

and is still not open to public inspection except under specified terms and conditions.[18]

The importance of this question is emphasized by the fact that Section 103 of the Patent Act of 1952 provides that a patent may be obtained if the *differences* between the subject matter sought to be patented and the PRIOR ART be such that the *subject matter as a whole* would not have been obvious to a person having *ordinary* skill in that art AT THE TIME THE INVENTION WAS MADE BY THE APPLICANT FOR PATENT. There is such uncertainty as to what is meant by the words "prior" and "art" as used in Section 103 in the term "prior art" that the matter should be settled by the Supreme Court.[19]

The Courts have stretched the use of "abandoned" applications to a point beyond that contemplated by the patent laws and even beyond the constitutional concept of promoting the progress of science and the useful arts by encouraging prompt and full disclosure to the public of the discoveries made by inventors. This is brought out in the opinion of Judge Jackson, speaking for the Court of Customs and Patent Appeals *In re Heritage,* 37 CCPA (Patents) 1109, 182 F. 2d 639. He stated that "any reference to a disclosure *which is*

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[18] An "abandoned" application, by definition, cannot possibly constitute "art" since it is not made, known or accessible to the public, as a matter of right. This can never come about under the present statute (35 U.S.C. 122) or rules (Patent Rule 14). After a patent issues, a member of the public may have access to the file of that patent, but must file with the Commissioner of Patents a "Petition for Access" to the file of any "abandoned" application referred therein to determine the contents of the latter. Prior to issuance of a patent making reference thereto, access may be had, if at all, only by consent of the applicant, the assignee or the attorney of record.

[19] See "Abandoned Applications as Prior Art"—Journal of the Patent Office Society, Vol. XLV No. 8, August, 1963, pp. 613 et seq.

available to the public is permissible" (emphasis added by petitioners), citing *Hamilton Laboratories, Inc.* v. *Massengill,* 111 F. 2d 584 (CA 6, 1940), cert. den. 311 U.S. 688, 61 S. Ct. 65, 85 L. Ed. 444. In the latter case a thesis on file in a college library was held to be a part of the "prior art". In the *Heritage* case an "abandoned" application referred to in a patent *issued before* the Heritage application was filed[20] was held to be proper evidence of the "prior" art.

While it appears to be a small step from treating a thesis in a college library as "art" to treating an "abandoned" patent application as "art", not too much violence is done so long as each is available to the public *prior* to the time a member of the public makes an invention or files an application for patent thereon. But now the Patent Office, in a proposed rule would make access to such applications or even knowledge of the existance thereof practically impossible. (Appendix B, page 4a.)

The Supreme Court has decried the rule by which Courts of Appeals have affirmed the judgment of the District Court where only two Appellate Judges vote for affirmance. In the trial of patent cases, particularly, such a rule should not be applicable. Nevertheless, the Court of Appeals for the District of Columbia, in the present case, relies upon the two-judge decision of *Asseff* v. *Marzall,* 189 F. 2d 660 (CADC 1951) to sustain the ruling of the District Court on the evidentiary effect of an earlier filed patent application as a reference to refuse a patent under 35 U.S.C. 103.

In *Asseff* v. *Marzall,* supra, relied upon by the Court of Appeals in the present case, however, the Court

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[20] The Heritage application was filed September 9, 1939, whereas the Finck *patent*, in which reference was made to an earlier filed abandoned application *issued* August 22, 1933.

went beyond all reasonable bounds. In that case, the Cook patent which was relied upon as a reference was a "copending patent" *at the time the Asseff application was filed,*[21] thus bringing the case squarely under the rule of *Alexander Milburn* v. *Davis-Bournonville,* supra.

All of the foregoing cases were decided before the effective date of the Patent Act of 1952.

There is set forth in Appendix D, page 21a, a table setting forth the cases decided prior to the Patent Act of 1952 and those decided since the effective date of that Act, wherein reliance has been placed on an "abandoned" application as a reference to refuse a patent.

It is respectfully submitted that the question of availability of "abandoned" applications as "art" or "prior art" is an important question imbued with a significant public interest since the principle applies not only when a patent is sought but also when the validity of an issued patent is contested in a Court action. Inasmuch as the appellate tribunals are far from being in agreement as to the applicability of

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[21] The Cook patent issued March 14, 1944, on an application filed November 8, 1941, whereas the Asseff application was not filed until September 9, 1942. Asseff admitted that the Cook application disclosed his invention but proved that he made the invention prior to November 8, 1941. He contended, therefore, that the reference was not "prior" art under the Milburn rule. However, the disclosure of an earlier filed Cook application as well as that part thereof which was carried forward into the application upon which the Cook patent was based were *direct anticipations* of the invention claimed by Asseff (See Opinion of Judge Tamm, deciding the case in that Trial Court, *Asseff* v. *Kingsland,* 86 F. Supp. 419, 423). Thus the earlier application was evidence of the fact that Asseff was not the first inventor of the subject matter of the invention claimed.

"abandoned" applications as references to *refuse* patents under 35 U.S.C. 103, the question presented in the present petition may be considered simultaneously with *Hazeltine* v. *Ladd,* supra.

VIII. CONCLUSION

Petitioners pray that the present petition be granted as to the first question since it is obvious that the public, the Patent Office and the inferior Courts are in dire need of a direction from the Supreme Court as to the burden of proof which is required of patent applicants to overcome the refusal of the Patent Office to issue a patent when they seek their statutory remedy in the respective Courts.

The second question, one aspect of which is already before the Court in *Hazeltine* v. *Ladd,* supra, should be considered in its entirety by the Court in order that it may have before it a case in point with respect to the use of "abandoned" applications as references as well as the use of "co-pending" patents as references, both in determining whether a patent should issue to another party and in determining the validity of a patent already issued.

Petitioners pray, therefore, that the petition, in its entirety, be granted.

Respectfully,

FRANCIS C. BROWNE
Counsel for Petitioners

Of Counsel:

J. D. WOLFE
Akron, Ohio.

APPENDIX A

Statutes

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

§ 122. Confidential status of applications

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

35 U.S.C. 133. *Time for prosecuting application.* Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

§ 141. Appeals to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal

to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

§ 142. Notice of appeal

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.

§ 143. Proceedings on appeal

The United States Court of Customs and Patent Appeals shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal.

§ 144. Decision on appeal

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of

appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

§ 145. Civil action to obtain patent

An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

APPENDIX B

I. Proposed Patent Office Rule

TITLE 37—PATENTS, TRADEMARKS AND COPYRIGHTS

Chapter I—Patent Office, Department of Commerce

PART 1—RULES OF PRACTICE IN PATENT CASES

Accessibility of Assignment Records

* * * *

The text of the proposed rule, as amended, reads as follows:

§ 1.12. *Assignment records open to public inspection.*—The assignment records, relating to original or reissue patents, including digests and indexes, are open to public inspection and copies of any instrument recorded may be

obtained upon payment of the fee therefor. Assignment records, digests and indexes, relating to any pending or abandoned application are not available to the public. Copies of any such assignment records and information with respect thereto shall be obtainable only upon written authority of the applicant or his assignee or attorney or agent or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided by these rules. An order for a copy of an assignment should give the identification of the record. If identified only by the name of the patentee and number of the patent, or in the case of a trademark registration by the name of the registrant and number of the registration, or by name of the applicant and serial number of the application, an extra charge will be made for the time consumed in making a search for such assignment.

(Sec. 1, 66 Stat. 793, 35 U.S.C. 6)

(Signed) EDWARD J. BRENNER,
Commissioner of Patents.

J. HERBERT HOLLOMON,
Assistant Secretary for Science and Technology.

Approved: May 26, 1965

Published in 30 F.R. 7195, May 28, 1965

II. Patent Office Rules

14. Patent applications preserved in secrecy. (a) Pending patent applications are preserved in secrecy. No information will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application

or papers relating thereto, without written authority of the applicant, or his assignee or attorney or agent, unless it shall be necessary to the proper conduct of business before the Office or as provided by these rules.

(b) Abandoned applications are likewise not open to public inspection, except that if an application referred to in a United States patent is abandoned and is available, it may be inspected or copies obtained by any person on written request, without notice to the applicant. Abandoned applications may be destroyed after 20 years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

108. **Abandoned and forfeited applications not cited.** Abandoned and forfeited applications as such will not be cited as references.

TIME FOR RESPONSE BY APPLICANT; ABANDONMENT OF APPLICATION

135. **Abandonment for failure to respond within time limit.** (a) If an applicant fails to prosecute his application within six months after the date when the last official notice of any action by the Office was mailed to him, or within such shorter time as may be fixed (rule 136), the application will become abandoned.

(b) Prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last official action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the examiner's action, but considera-

tion of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

(d) Prompt ratification or filing of a correctly signed copy may be accepted in case of an unsigned or improperly signed paper. (See rule 7.)

137. **Revival of abandoned application.** An application abandoned for failure to prosecute may be revived as a pending application if it is shown to the satisfaction of the Commissioner that the delay was unavoidable. A petition to revive an abandoned application must be accompanied by a verified showing of the causes of the delay, by the proposed response unless it has been previously filed, and by the petition fee.

138. **Express abandonment.** An application may be expressly abandoned by filing in the Patent Office a written declaration of abandonment, signed by the applicant himself and the assignee of record, if any, and identifying the application.

APPENDIX C (1)

I. Decisions of Patent Office Board of Appeals

IN THE UNITED STATES PATENT OFFICE

Paper No. 14

Before the Board of Appeals

Appeal No. 20063

Ex parte Thomas H. Rogers, Jr.

Newell R. Bender and Theodore B. Burkholder

Application for Patent filed June 8, 1955, Serial No. 514,106. Pressure Mixing Process for Producing Cellular Products. R. L. Miller and F. W. Brunner and J. S. Holden for appellants.

Before Asp and Magil, Examiners-in-Chief, and J. S. Baily, Acting Examiner-in-Chief.
Magil, Examiner-in-Chief.

This is an appeal from the decision of the Primary Examiner finally rejecting claims 1 to 9, all of the claims in the application.

Claim 1 which is representative of the appealed claims is as follows:

1. In the process of preparing flexible elastomeric cellular structures from liquid reaction mixtures containing a polyisocyanate, water and an active-hydrogen-containing polymeric material selected from the group consisting of polyalkylene ether glycols, polyesteramides and polyesters, said polyesters being prepared from at least one glycol and at least one dibasic carboxylic acid, the improvement which comprises mixing the reaction mixture under a pressure ranging from 0.5 to 60 pounds per square inch above atmospheric pressure.

The reference relied upon is:

Hoppe et al. 2,764,565 Sept. 25, 1956

(Filed August 8, 1955; continuation-in-part of Serial No. 327,522, Filed December 23, 1952).

The Hoppe et al. patent carries forward the subject matter of the parent application Serial No. 327,522, but adds substantially thereto. Accordingly, only that disclosure which was originally presented in application Serial No. 327,522 is available as a reference against the claims of the instant application.

Appellants' process as well as that of the reference is sufficiently described in the appeal brief and in the Examiner's answer.

Appellants allege invention in only one aspect of the disclosed method for preparing cellular polyurethane products and that is the concept of mixing the reactants while under a pressure of from 0.5 to 60 pounds per square inch above atmospheric pressure.

The Examiner's position is that normal operation of the injection device shown in detail in Figure 2 of application Serial No. 327,522 would result in a build up of pressure in the mixing chamber 8 which must be greater than atmospheric for the mixture to flow from the outlet against the pressure of the atmosphere. To this extent, the Examiner's position is manifestly in accordance with known scientific principles. It is also considered obvious that the pressure within chamber 8 will be governed by factors including the rate of flow of materials through the chamber and the frictional resistance to fluid flow through the outlet as determined by, among other things, the diameter of the outlet and the viscosity of the mixture. While we must agree with appellants that the pressure behind the

nozzles feeding materials to the mixing chamber would have little direct relationship to the pressure within the chamber, we conclude that operation of the device in accordance with the disclosure of the reference would, under many conditions within the purview thereof, result in pressures in the mixing chamber within the scope of claims 1 to 9, and we are accordingly of the opinion that the claims define nothing patentable over the cited reference.

We agree with the Examiner that the affidavit of Bander is lacking as to factual data relating to the structure of the apparatus and procedural data as to the conditions of operation. However, it does indicate that very small variations in operating conditions well within the scope of the reference disclosure, such as the 1/32 "change in nozzle diameter between "Experiment I" and "Experiment II," may result in substantial variation in mixing chamber pressure in apparatus of this type.

The affidavit of Rogers is similarly lacking in factual data.

The Examiner presents a second ground for rejection of the claims as unpatentable over the cited reference, which is that page 5, lines 15 to 26, of the reference application discloses premixing of all of the components of the reaction mixture under pressure in a common mixing nozzle. The cited lines present several alternative procedures among which is included introduction of the activator through the common mixing nozzle which feeds both the polyester and the diisocyanate. We will also sustain this ground of rejection.

Appellants' arguments have been carefully considered, but, for the reasons indicated above, as well as for those set forth in the Examiner's answer, we conclude that the

appealed claims define nothing patentable over the cited reference.

The decision of the Examiner is affirmed.

Affirmed

Board of Appeals

N. A. Asp
Examiner-in-Chief

H. Magil
Examiner-in-Chief

J. S. Bailey
Examiner-in-Chief
(Acting)

J. B. Holden
The Goodyear Tire & Rubber Co.
Akron, Ohio

IN THE UNITED STATES PATENT OFFICE

Paper No. 16

Before the Board of Appeals

Appeal No. 200-63

Ex parte Thomas H. Rogers, Jr.

Newell R. Bender and Theodore B. Burkholder

Application for Patent filed June 8, 1955, Serial No. 514,106. Pressure Mixing Process for Producing Cellular Products. R. L. Miller and F. W. Brunner and J. B. Holden for appellants.

Before Asp and Magil, Examiners-in-Chief, and J. S. Bailey, Acting Examiner-in-Chief.

Magil, Examiner-in-Chief.

Request for Reconsideration

This is a request for reconsideration of our decision affirming the Examiner in his rejection of all of the claims

in this application. We have reconsidered the decision in the light of appellants' request and find no sufficient reason for coming to any different conclusion.

Relative to the Examiner's second ground of rejection, the mode of operation of the device of the Hoppe et al. reference is considered to be correctly interpreted in the Examiner's answer and in our decision of November 13, 1961. Inclusion of water along with the other ingredients in the common mixing nozzle described on page 5, lines 15 to 26, of the reference application for the stated purpose of foaming the plastic is regarded as within the purview of the disclosure.

Appellants submit four patents, all filed since the issuance of the Hoppe et al. patent, as evidence of their contention that no superatmospheric pressure would be built up in the mixing chamber of the reference Hoppe et al. application. The general rule of long standing that what has been allowed in other applications or patents will not be considered as evidence of patentability is considered properly applicable in this case. See *In re* Atwood, 46 CCPA 901; 747 O.G. 4; 267 Fed.(2d) 954; 122 USPQ 378; 1959 C.D. 321.

The petition has been considered but is denied with respect to making any change in our decision.

Board of Appeals

N. A. Asp
Examiner-in-Chief

H. Magil
Examiner-in-Chief

J. S. Bailey
Examiner-in-Chief
(Acting)

J. B. Holden
The Goodyear Tire & Rubber Co.
Akron, Ohio

APPENDIX C (2)

Decision of District Court

Filed December 20, 1963

OPINION

This is a civil action brought pursuant to 35 U.S.C. 145 in which plaintiffs seek judgment authorizing the defendant, Commissioner of Patents, to issue a patent containing claims 1 to 9, inclusive, of application Serial No. 514,106 filed by co-plaintiffs, Thomas H. Rogers, Newell R. Bender, and Theodore B. Burkholder on June 8, 1955. The co-plaintiff, Goodyear Tire and Rubber Co., is the assignee of the inventors.

No claims were allowed by the Patent Office. After the trial, counsel for plaintiffs withdrew claim 1 from the present action, and thus claims 2 to 9, inclusive, are before this Court. The parties agree that all these claims stand or fall together.

All the claims in suit are directed to an improved process of producing flexible, elastomeric cellular materials, i.e., polyurethane foams. The alleged invention resides in the concept of mixing the liquid reactant mixture of polymeric material, polyisocyanate and water under a pressure of from 0.5 to 60 pounds per square inch gauge.

The Board of Appeals affirmed the Examiner's rejection of the claims in suit as being unpatentable over the Hoppe et al. patent No. 2,764,565, which issued on application Serial No. 527,106, filed August 8, 1955. That application is a continuation-in-part of the now abandoned application Serial No. 327,522 filed December 23, 1952. The parties agree that only the disclosure brought forward from application Serial No. 327,522 is available as a reference since only that disclosure has a filing date earlier than the filing date of plaintiffs' application.

The Hoppe et al. application, Serial No. 327,522, discloses a process and apparatus for continuously preparing a stream of polyurethane plastic. The invention there resides in the intermittent injection of at least one of the reactants into a mixing chamber containing a continuously flowing stream of reactants. These injections are made through nozzles at high pressures—up to 1000 atmospheres —and frequencies. Additional stirring means are employed in the chamber so as to insure that the uniformly mixed stream of reactants is discharged therefrom in the liquid state and before any substantial liberation of gases has taken place.

That application also briefly discloses a modification of the above-described apparatus. "In this modification, the two components of the reaction mixture . . . are conveyed separately to a mixing chamber into which they are injected under pressure through separate nozzles, or a common mixing nozzle, and the activator is either conveyed separately to the mixing chamber and injected into it under pressure through a separate nozzle, or the common mixing nozzle, or is conveyed to the mixing chamber in admixture with one of the said components."

The tribunals of the Patent Office concluded that since in this modification *all* the liquid reactants are injected under pressure through the common mixing nozzle into a mixing chamber, it would have been obvious to one having ordinary skill in the art to mix all the liquid reactants under pressure in the manner recited by the claims in suit.

Undeniably, there are differences between the Hoppe et al. modification, and the claimed process. Hoppe et al. discloses that all the reactants are injected under pressure through a "common mixing nozzle" into a mixing chamber, or, in other words, the reactants are mixed under pressure as they pass through the nozzle, while the claims in suit recite that all the reactants are simply mixed under specified range of pressures in a chamber.

Therefore, the issue facing this Court is whether or not these differences are such that the claimed subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. In deciding this issue, the writer is mindful that the decision of the tribunals of the Patent Office is presumed to be correct, *Cook* v. *Watson,* 181 F. Supp. 896 (D.C.D.C. 1960), and that it should be followed unless the evidence introduced at trial demonstrates that there is clear error or lack of rational basis in that decision. *Abbott et al.* v. *Coe,* 109 F. 2d 449 (C.A.D.C. 1939), and *Schaefer* v. *Watson,* 288 F. 2d 144 (C.A.D.C. 1961).

It seems apparent to the writer that if Hoppe et al. can be said to suggest to one skilled in the art the concept of mixing liquid reactants under pressure in a chamber, the recitation of the range of pressures in the claims cannot be the basis for patentability. This is because that once that concept is realized, it would appear to require only ordinary engineering skill to find the specified range claimed.

In reaching a decision, the state of the art as of 1954-1955 must be examined since it is one of the best means by which a court can determine what would or would not have been obvious to a skilled person in the art. See *Upjohn Co.* v. *Italian Drugs Importing Co., Inc.,* 128 U.S.P.Q. 236 (D.C.S.N.Y. 1961).

From their introduction in the early 1950's, polyurethane foams had developed to the point that in early 1955, people working in the polymer field generally believed that polyurethane foam would be the next great synthetic. By this time, numerous companies, both foreign and domestic, were actively seeking processes which would permit large scale commercialization of this product. See the March 1955 issue of *Fortune* magazine.

Goodyear, one of the largest makers of conventional latex foam, was also one of the most active of these companies, and to further its development efforts, it had taken technical "know-how" licenses from several other competing companies, among whom was the Mobay Chemical Co., the United States licensor of the Hoppe et al. application. Several months after obtaining a license from Mobay, the application in suit was filed, and approximately one month thereafter Hoppe et al. filed their continuation-in-part application Serial No. 527,106.

Plaintiffs' evidence showed that none of the Mobay technical personnel had mentioned or suggested that maintaining a pressure in the mixing chamber would produce a greatly improved product. In fact, the first time that Mobay is purported to have told its licensees (including Goodyear) about this development was approximately a year after plaintiffs' application had been filed.

Since the record does not show that Goodyear told Mobay about the invention, and since there can be little doubt that the disclosure in the Hoppe et al. continuation-in-part application would be a complete anticipation of plaintiffs' invention if it had been filed early enough, it is apparent that at least two sets of inventors made the same invention at approximately the same time. This fact, coupled with the fact that the evidence did not show that plaintiffs' invention solved a long standing problem in the art, (this was understandable since the art was a relatively new, rapidly expanding one, and one in which a great many companies were actively engaged in development work) tends to negate plaintiffs' contention that their invention was an unobvious advance in the art. See *Audio Devices, Inc.* v. *Armour Research Foundation of Illinois Institute of Technology,* 130 U.S.P.Q. 323 (C.A. 2 1961); *Saul* v. *International Harvester Co.,* 120 U.S.P.Q. 177 (D.C. E. Wis. 1959), and *Clapper* v. *Original Tractor Cab Co., Inc.,* 116 U.S.P.Q. 316 (D.C. S. Ind. 1958).

Of course it should also be noted that during the trial, several expert witnesses testified that plaintiffs' invention would not have been obvious to them in view of the disclosure in the Hoppe et al. application. However, this opinion evidence must be balanced and tested against the above-mentioned facts. Admittedly, this case is extremely close, but for the reasons given above, the Court cannot say that the tribunals of the Patent Office were clearly erroneous in holding that the claims in suit were unpatentable over the Hoppe et al. patent.

Clearly, plaintiffs' invention resulted in an improved product. However, an improved product or result does not necessarily mean that the claims to the process of making that product or producing that result are patentable. See *In re Larson,* 130 U.S.P.Q. 209 (C.C.P.A. 1961); *In re Ross & Davis,* 134 U.S.P.Q. 320 (C.C.P.A. 1962), and *Benger Labs., Ltd.* v. *R. K. Laros Co.,* 135 U.S.P.Q. 11 (D.C. E. Pa. 1962).

In view of the above holding, the Court deems it unnecessary to discuss the other grounds of rejection made by the tribunals of the Patent Office and counsel for defendant.

In view of what has hereinbefore set out, the Court holds that the decision of the Board of Appeals has not been shown to be in clear error, and that judgment should issue for the defendant and against the plaintiffs.

The foregoing Opinion includes Findings of Fact and Conclusions of Law.

DATED: December 20, 1963.

JOSEPH R. JACKSON
Judge

APPENDIX C (3)

Decision of Court of Appeals

UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 18,440

GOODYEAR TIRE AND RUBBER COMPANY, ET AL., APPELLANTS

v.

DAVID L. LADD, COMMISSIONER OF PATENTS, APPELLEE

Appeal from the United States District Court
for the District of Columbia

Decided June 24, 1965

Mr. Francis C. Browne for appellants.

Mr. Jack E. Armore, Attorney, United States Patent Office, with whom *Mr. Clarence W. Moore,* Solicitor, United States Patent Office, was on the brief, for appellee.

Before BAZELON, *Chief Judge,* EDGERTON, *Senior Circuit Judge,* and WASHINGTON, *Circuit Judge.*

PER CURIAM: The Patent Office rejected appellants' application, filed June 8, 1955, for a patent on the process of mixing the ingredients of polyurethane foams at pressures of 0.5 to 60 pounds per square inch above atmospheric pressure. The use of such pressures during mixing allegedly results in uniform and controlled cell size and eliminates fissures in the end product. Appellants then sued the Commissioner of Patents in the District Court under 35 U.S.C. § 145 for a declaration that they are entitled to the patent. The District Court entered judgment

for the defendant and dismissed the complaint, and the plaintiffs appeal.

Both the Patent Office and the District Court held the process unpatentable because the prior art made it obvious to a person with ordinary skill in the art, 35 U.S.C. § 103, relying on the Hoppe *et al.* patent No. 2,764,565, the application for which was filed two months after appellants' application. Hoppe's application was a continuation in part of an abandoned application filed two and a half years before appellants' application, and the parties agreed in the trial court that the continuation-in-part application is available as a reference to the extent its disclosures are also contained in the abandoned application. Though appellants now contest this, we have already held that, "as to all subject matter carried over into the continuing application from the parent application, the former is entitled to the filing date of the latter." *Asseff* v. *Marzall,* 88 U.S.App.D.C. 358, 359, 189 F. 2d 660, 661, *cert. denied,* 342 U.S. 828 (1951). The Hoppe *et al.* abandoned application discloses an apparatus for the production of polyurethane plastics, including foamed products. Under one modification of the apparatus the ingredients are conveyed simultaneously through a common mixing nozzle and injected under pressure "up to 1000 atmospheres" into a mixing chamber.[1] This modification was carried forward

[1] "In this modification the two components of the reaction mixture, namely at least one di-isocyanate and at least one hydroxyl-group-containing polyester, are conveyed separately to a mixing chamber into which they are *injected under pressure through* separate nozzles or a *common mixing nozzle,* and the activator is either conveyed separately to the mixing chamber and *injected into it under pressure through* a separate nozzle or the *common mixing nozzle* or is conveyed to the mixing chamber in admixture with one of the said components." Hoppe abandoned application, serial No. 327,522. "The reaction components and activator are preferably injected into the mixing chamber at a pressure up to 1000 atmospheres, the homogeneity and strength of the end product of porous or homogenous structure being thus improved." *Id.*

into the continuation-in-part application. See Hoppe *et al.* patent No. 2,764,565 (Sept. 25, 1956).

The Patent Office held that this disclosure would suggest the process of mixing the ingredients under pressure to one with ordinary skill in the art. Although some evidence at trial conflicted with this holding, the District Court agreed with the Patent Office, relying on its expertness and stating that obviousness was indicated by the facts that another inventor had discovered the process at about the same time as appellants did and that the problem was not of long standing in the art.[2]

The Patent Office's expertness in determining technical questions such as obviousness requires affirmance of its judgments unless they have no rational basis.[3] Since the Patent Office's finding of obviousness is supported by the record, the District Court's judgment is not clearly erroneous.[4] Therefore, the judgment must be

Affirmed.

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[2] See *L-O-F Glass Fibers Co.* v. *Watson,* 97 U.S.App.D.C. 69, 228 F. 2d 40 (1955), suggesting that the length of time a problem has existed is relevant to whether a solution to it is obvious.

[3] See *Schafer* v. *Watson,* 109 U.S.App.D.C. 360, 288 F. 2d 144 (1961); *Esso Standard Oil Co.* v. *Sun Oil Co.,* 97 U.S.App.D.C. 154, 229 F. 2d 37, *cert. denied,* 351 U.S. 973 (1956); *Abbott* v. *Coe,* 71 App.D.C. 195, 109 F. 2d 449 (1939).

[4] Rule 52(a), F.R.Civ.P., 28 U.S.C.A., governs our review of the District Court's opinion. *Schafer* v. *Watson,* note 3 *supra; Esso Standard Oil Co.* v. *Sun Oil Co.,* note 3 *supra; Standard Oil Development Co.* v. *Marzall,* 86 U.S.App.D.C. 210, 181 F. 2d 280 (1950).

APPENDIX D

Cases Dealing With Abandoned Applications as "Prior Art"

Rolls-Royce Ltd. v. *U. S.*, 339 F. 2d 654 (Ct. Cls. 1964)

Abandoned application referred to in an issued patent is evidence of "prior knowledge" of the claimed invention under 102(e) if early enough.

Technograph Printed Circuits, Ltd. v. *Bendix Aviation Corp.*, 218 F. Supp. 1 (W.D. Md. 1963) aff'd F. 2d 497 (C.A. 4 1964).

Abandoned application referred to in an issued patent is evidence of non-invention under § 103 where the issue date of the referenced issued patent was 4 years *prior* to the filing date of the patent in suit.

Ex parte Lipkin, 129 USPQ 427 (P.O. Bd. App. 1960).

Where Official Gazette abstract of abandoned application is used as a reference, entire application is evidence of public knowledge only as of date of publication of abstract.

Ex parte Gresham & McAlevy, 90 USPQ 350 (P.O. Bd. App. 1951).

Abandoned application referred to in issued patent is only useful as a reference *if* patentee relied upon the application for disclosure or if there is a special relation between them.

Ex parte Shacter & Griffith, 139 USPQ 380 (P.O. Bd. App. 1962).

If an abandoned application is referred to and relied upon by the patentee of an issued patent, it is a reference.

Ex parte MacDonald, 113 USPQ 262 (P.O. Bd. App. 1956).

Matter in abandoned application which is not carried over into continuing application *and* is not relied upon therein for completion of its disclosure is not available

as a reference against one who filed while first application was pending and secret.

B. F. Goodrich Co. v. *U. S. Rubber Co.*, 147 F. Supp. 40 (D.C. Md. 1956).

Abandoned application is evidence of "prior knowledge" of the claimed invention under 102(a).

Ex parte Tummers & Haayman, 137 USPQ 444 (P.O. Bd. App. 1962).

Continuation-in-part application disclosed only z. Parent application disclosed x + y + z.

Parent is good as a reference for z only. Since continuation-in-part application did not rely upon parent, the latter disclosure is not carried forward.

APPENDIX E

February 21, 1793, Chap. XI, Unitetd States Statutes at Large

SEC. 9. And be it further enacted, That in case of interfering applications, the same shall be submitted to the arbitration of three persons, one of whom shall be chosen by each of the applicants, and the third person shall be appointed by the Secretary of State; and the decision or award of such arbitrators, delivered to the Secretary of State, in writing and subscribed by them, or any two of them, shall be final, as far as respects the granting of the patent: And if either of the applicants shall refuse or fail to chuse (sic) an arbitrator, the patent shall issue to the opposite party. And where there shall be more than two interfering applications, and the parties applying shall not all unite in appointing three arbitrators, it shall be in the power of the Secretary of State to appoint three arbitrators for the purpose.

July 4, 1836, Chap. CCCLVII, United States Statutes at Large

SEC. 7 And be it further enacted, That, on the filing of any such application, description, and specification, and the

payment of the duty hereinafter provided, the commissioner shall make or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination, it shall appear to the commissioner that the applicant is not the original and first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new. In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back $20.00, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the commissioner, shall be sufficient warrant to the treasurer for paying back to the said applicant the said sum of $20.00. But if the applicant in such case shall persist in his claim for a patent, with or without any alteration of the specification, he shall be required to make oath or affirmation anew, in manner as aforesaid. And if the specification and claims shall not have been so modified as, in the opinion of the commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the

decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing, of the opinion and decision of the commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the commissioner to furnish to the board of examiners such information as he may possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the commissioner, either in whole or in part, and their opinion being certified to the commissioner, he shall be governed thereby in the further proceedings to be had on such application: provided, however, That before a board shall be instituted in any such case, the applicant shall pay to the credit of the Treasury, as provided in the ninth section of this act, the sum of $25.00 and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding $10.00, to be determined and paid by the commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

July 4, 1836, Chap CCCLVII, United States Statutes At Large

Sec. 16. And be it further enacted, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of Examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in an such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided however,* That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

(This review by bill in equity is considered in detail in a subsequent section of this paper.)

APPENDIX F

Cases Showing No Presumption of Correctness Given Patent Office Ruling By CCPA

In re Reid, 179 F. 2d 998 (CCPA 1950)

Express holding of Board is not controlling before CCPA on appeal.

In re Pappas et al., 185 F. 2d 695 (CCPA 1950)
In re Hummer, 241 F. 2d 742 (CCPA 1957)
In re Citron, 251 F. 2d 619 (CCPA 1958)

Any doubts as to patentability should be decided in favor of the applicant.

In re Knapp-Monarch, 296 F. 2d 230 (CCPA 1961)

Any finding of fact by the Board of Appeals may be challenged simply by contrary evidence on appeal.

In re Dwyer et al., 317 F. 2d 203 (CCPA 1963)

Patent Office interpretation of statement in reference is not binding.

In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 601

THE GOODYEAR TIRE AND RUBBER COMPANY, ET AL., PETITIONERS

v.

COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the district court (Pet. App. 13a–17a) [1] is reported at 224 F. Supp. 781. The opinion of the court of appeals (Pet. App. 18a–20a) is not yet reported.

JURISDICTION

The judgment of the court of appeals was entered on June 24, 1965. The petition for a writ of certiorari was filed on September 22, 1965. The juris-

[1] "Pet. App." references are to the appendix to the petition. "Pet." references are to the petition. "J. A." references are to the Joint Appendix in the court of appeals, nine copies of which have been filed in this Court.

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diction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

1. Whether, in a district court suit under 35 U.S.C. 145 to review the Patent Office's refusal to grant a patent, the Patent Office's conclusion regarding obviousness in light of the prior art under 35 U.S.C. 103 should be affirmed unless found to be clearly erroneous.

2. Whether disclosures originally filed before the application in issue, and carried forward in a continuation-in-part application ultimately issued before the application in issue, may be used as a prior art reference to determine obviousness under 35 U.S.C. 103.

STATUTE INVOLVED

Title 35, United States Code, provides in relevant part:

> Section 103. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Section 145. An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have

remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue . . . a patent on compliance with the requirements of law. * * *

STATEMENT

Petitioners Rogers, Bender and Burkholder allege the invention of an improved process for the preparation of flexible cellular materials. Petitioner Goodyear Tire & Rubber Company is the assignee of their interests in the process. By application filed with the Patent Office on June 8, 1955, a patent for the process was sought (Pet. App. 13a).

The claim was denied by the patent examiner (J.A. 289–291, 293–294) on the ground that the process lacked patentability over certain disclosures contained in an outstanding patent, Hoppe et al., No. 2,764,565. The Patent Office Board of Appeals affirmed (Pet. App. 8a–11a, 11a–12a). Petitioners then brought this suit in the district court under 31 U.S.C. 145 seeking a declaration that they were entitled to a patent as applied for. In bringing the suit, petitioners conceded that certain disclosures brought forward in the Hoppe patent as a continuation-in-part of an abandoned 1952

application were a proper reference (Pet. App. 13a, 19a; J.A. 21-22).[2]

After a four-day trial at which new evidence was received, the district court entered judgment for the Commissioner (Pet. App. 14a–17a). The court noted that the issue was one of the obviousness of the advance in the art, and that on that issue the decision of the Patent Office "is presumed to be correct" and "should be followed unless the evidence introduced at trial demonstrates that there is clear error or lack of rational basis in that decision" (Pet. App. 15a). After a thorough examination of the facts, the court concluded that "this case is extremely close," but that it could "not say that the tribunals of the Patent Office were clearly erroneous in holding that the claims in suit were unpatentable over" Hoppe (Pet. App. 17a).

The court of appeals affirmed in a brief *per curiam* opinion (Pet. App. 18a–20a). Citing three of its earlier precedents on the issue, the court noted that the Patent Office's resolution of technical issues such as obviousness "requires affirmance of its judgments unless they have no rational basis" and found that, although there was some contrary evidence, the finding of obviousness "is supported by the record" (Pet. App. 20a). With regard to the relevance of the Hoppe references, the court recognized that petitioners had conceded this issue in the district court but went on to hold that, in any event, the Hoppe reference was a relevant reference as a continuation-in-part of an

[2] Petitioners sought to retreat from this concession in the court of appeals (Pet. App. 19a).

abandoned application predating the application in issue.

ARGUMENT

1. There is no substance to petitioner's contention that the courts below erred in refusing to overturn the Patent Office's determination of obviousness unless found to be clearly erroneous on the basis of the record made in the district court.[3] Such deference was required.[4] As this court ruled with respect to determinations by the Patent Office of the similar question of priority of invention, "* * * the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction"; if the question is "* * * doubtful the decision of the Patent Office must control." *Morgan* v. *Daniels*, 153 U.S. 120, 125. This test has been repeatedly followed by the court below in refusing to overturn Patent Office decisions on technical issues. See *e.g.*, *Abbott* v. *Coe*, 109 F. 2d 449, 451 (C.A.D.C.); *Esso Standard Oil Company* v. *Sun Oil Company*, 229 F. 2d 37, 42 (C.A.D.C.), *certiorari denied*, 351 U.S. 973; *Schafer* v. *Watson*, 288 F. 2d 144, 145 (C.A.D.C.). Despite a slightly different verbal formulation in the opinion in this case (the court, indeed, has recognized that varying

[3] A similar issue is presented in *Sheldon L. Pollack et al.* v. *Commissioner of Patents*, No. 413, now also pending on petition for a writ of certiorari. The Commissioner's brief in opposition to that petition was filed on September 3, 1965.

[4] Petitioners' claim that they have been denied due process was not raised below. The assertion in this Court (Pet. 16–17) is unsupported by reasons or authority.

verbalizations of the same test have occurred in its opinions, see *Besser* v. *Ooms*, 154 F. 2d 17, 18 (C.A.D.C.)) the supporting citations make it clear that no different test was, in substance, employed here (Pet. App. 15a, 20a).[5]

2. Both tribunals of the Patent Office and the two courts below found petitioners' 1955 application unpatentable as obvious in light of disclosures contained in the 1952 Hoppe application.[6] In the district court, petitioners agreed that such prior disclosures, carried

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[5] Nor is it likely, as petitioners suggest (Pet. 15–16), that any different test would have been employed if, instead of seeking a new evidentiary hearing in the district court under 35 U.S.C. 145, petitioners had elected to appeal directly to the Court of Customs and Patent Appeals under 35 U.S.C. 144. For while that court has said that, as a general matter, doubts as to patentability should be resolved in favor of the applicant, see *e.g.*, *In re Citron*, 45 C.C.P.A. (Patents) 773, 251 F. 2d 619, the court also follows the rule that, on an appeal from the decision of the Patent Office, concurrent findings of the administrative tribunals as to obviousness or lack of invention will be persuasive in case of doubt. See *In re Kaufmann*, 39 C.C.P.A. (Patents) 769, 193 F. 2d 331; *In re Smith*, 34 C.C.P.A. (Patents) 1007, 161 F. 2d 274.

[6] The essence of the alleged invention in petitioners' process is the mixing of the ingredients of polyurethane foams at pressures of 0.5 to 60 pounds per square inch above atmospheric pressure to achieve a better end product whose cells are of a uniform and controlled size and which has fewer fissures (Pet. App. 9a, 13a, 18a; J.A. 274). The idea of thus using pressure in the mixing of the ingredients for polyurethane foams was clearly present in the 1952 Hoppe application, which described an apparatus for the production of polyurethane plastics, including foamed products, and told of one modification of the apparatus in which components of the mixing ingredients were injected either through separate nozzles or through a common mixing nozzle into a mixing chamber at a pressure of up to 1000 atmospheres to improve the homogeneity and strength of the end product (Pet. App. 14a, 19a; J.A. 350, 351).

forward in a continuation-in-part application filed by Hoppe shortly after petitioners' application, were a relevant reference in judging the patentability of petitioners' application. See Statement, pp. 3–4, *supra*, at note 2. Petitioners attempted to retreat from their concession in the court of appeals, and that court, while noting that the concession had been made, also held the 1952 disclosures to be proper references regardless of the concession because carried forward into the later Hoppe patent application (Pet. App. 19a).

The court of appeals was clearly correct in giving the relevant Hoppe disclosures a 1952 filing date, since they were a continuation of an application originally filed at that time. See *Asseff* v. *Marzall*, 189 F. 2d 660, 661 (C.A.D.C.). Thus the Hoppe disclosures were properly treated as part of a patent "copending" with the petitioners' application.[1] The remaining question raised by petitioners—whether "copending" patent applications are relevant references in determining obviousness under 35 U.S.C. 103—is presented in *Hazeltine Research, Inc., et al.* v. *Commissioner*, No. 57, this Term, certiorari granted, 380 U.S. 960. The Commissioner's position in that case, upheld by the court of appeals in *Hazeltine* and in this case, is that copending patents *are* relevant references under Section 103.

In view of petitioners' agreement in the district court that the disclosures in the 1952 Hoppe application were available as references to determine the

[1] A "copending patent" is one applied for before the invention and application in issue but granted after the application in issue.

patentability of their application, we do not believe the question in *Hazeltine* to be properly presented in this case. Hence, we submit that the petition for certiorari should be denied. However, inasmuch as the court of appeals appears to have passed upon the question as an alternative ground of decision after petitioners abandoned their district court concession, this Court may conclude that that question is appropriate for its consideration. See *Friend* v. *Talcott*, 228 U.S. 27, 36; cf. *Jones* v. *United States*, 362 U.S. 257, 272. If the Court does so conclude, we respectfully suggest that it defer action on the instant petition pending its decision on the merits in *Hazeltine*.

CONCLUSION

The petition for a writ of certiorari should be denied. In the alternative, action on this petition should be deferred pending the Court's decision on the merits in No. 57, *Hazeltine Research, Inc., et al.* v. *Commissioner*.

Respectfully submitted.

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OCTOBER 1965.

U.S. GOVERNMENT PRINTING OFFICE: 1965

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 601

THE GOODYEAR TIRE & RUBBER COMPANY, ET AL.,
Petitioners

v.

COMMISSIONER OF PATENTS, *Respondent*

On Petition for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit

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REPLY BRIEF FOR PETITIONERS

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1. Question 2 Misleading As Stated in Respondent's Brief in Opposition

Respondent's Brief in Opposition, page 2, states the second question in misleading fashion. The Trial Court held in the present case that "Undeniably, there are differences between the Hoppe et al. modification [i.e., the "abandoned" application or, as described by respondent, "the disclosures originally filed before the

application in issue" (Respondent's Brief, page 2)], and the claimed process." (JA 14). The Trial Court held, however, that the Hoppe et al. "continuation-in-part application" which was filed *after* the application in issue "would be a complete anticipation of plaintiffs' invention *if it had been filed early enough*" (Emphasis Petitioners') (JA 15). It necessarily follows that the "abandoned" application was not admissible as evidence of "prior invention" under 35 U.S.C. 102 since it did not disclose the claimed process and was not admissible as evidence of "prior art" under 35 U.S.C. 103 since it was not "known" or "available" at the time petitioners' application was filed.

The continuation-in-part application was neither evidence of "prior invention" under 35 U.S.C. 102 or "prior art" under 35 U.S.C. 103 since it was not "prior" to petitioners in any sense of the word, having been filed *after* petitioners' application. The subject matter which would have made the continuation-in-part application a "complete anticipation . . . if it had been filed early enough" was not "carried forward" from the "abandoned" application. It was "new matter" in the later filed application.

Thus, it is obvious that the fact situation and question presented here differs from that involved in *Hazeltine et al.* v. *Commissioner,* No. 57, October Term, 1965, but there is an overlapping of the legal principle involved, namely, whether or not an earlier filed "abandoned" application is evidence of the "prior art" under 35 U.S.C. 103 as well as evidence of "prior invention" under 35 U.S.C. 102. In Hazeltine, the application in issue was filed *after* the reference application (a "co-pending patent" which did not describe the invention claimed by Hazeltine) but the claimed invention was

made by the applicant (Hazeltine) before the filing date of the reference application. The distinction in this regard is well brought out in the Brief Amicus filed by Mr. Aisenberg in the Hazeltine case (See No. 919, October Term, 1965).

2. Petitioners Join in Respondent's Alternative Recommendation as to Action on Second Question Presented in Petition

Petitioners respectfully join in respondent's *alternative* recommendation (Brief for Respondent, page 8) to the extent that action on the present petition with respect to the *second* question (avilabilty of " abandoned applications" as evidence of "prior art" under 35 U.S.C. 103) be deferred pending the decision of the Court in No. 57, *Hazeltine Research, Inc. et al.* v. *Commissioner.*[1]

At the same time, however, petitioners respectfully urge the Court to consider the effect of the Brief Amicus filed in the Hazeltine case by Irwin M. Aisenberg, Esquire (No. 919, October Term, 1965) on the points raised in the present petition, as well as those raised in the Hazeltine case.

Whereas the reference relied on by the Patent Office in the Hazeltine case is a "copending patent" of *another party,* the Brief Amicus of Mr. Aisenberg discusses, among other things, a fact situation where the reference is a "copending patent" of the *same inventor.* It also distinguishes between the term "prior art" as used in Section 103 and the term "prior invention" as used in Section 102.

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[1] Counsel for petitioners is advised by the Clerk that oral argument in the Hazeltine case is presently set for the week of November 15, 1965.

It is pointed out at page 13 of the Brief Amicus (No. 919), by reference to the commentary of Mr. Federico on Section 103 of the new patent act, that to be "prior art" a reference must at least be "available". Since the patent statutes and the Patent Office rules maintain pending and abandoned applications in secrecy, they cannot be construed as part of the "prior art" unless and until they become "available" to those skilled in the art.

The fact situation in the present case is that the reference relied on by the Patent Office and the courts is an "abandoned application" of another party, to which reference was made in a "continuation-in-part application" filed by that same party *after* the petitioners' application was filed. The "abandoned application" did not "anticipate" petitioners' claimed process but due only to the "new matter" in the "continuation-in-part application" of that party, the latter would have been an "anticipation" of petitioners' claimed invention *if the "continuation-in-part" application had been filed early enough to antedate petitioners' application.* In this respect, the reference (i.e., the Hoppe et al. *patent*) used against petitioners' application was not even a "copending patent" as that term is defined by counsel for respondent (Brief for Respondent, footnote 7, page 7), or as defined in Hazeltine, since it was not "applied for before the invention and application in issue".

So long as the Court takes cognizance of the fact situation in the present case in reaching its decision in the Hazeltine case, petitioners do not feel that they would be prejudiced by a delay in action on the second question presented in this petition, as recommended in the alternative by counsel for respondent.

It should be noted, however, that an affirmance of the decision of the Court of Appeals in the Hazeltine case might not dispose of the question presented herein since the Hazeltine case does not involve an "abandoned application" which never issued as a patent or a "continuation-in-part application" filed *after* the application in issue. A reversal of the Court of Appeals in Hazeltine, on the other hand, would constitute a basis for summary reversal of the Court of Appeals on the second question presented herein.

In the event the Court affirms in the Hazeltine case, petitioners respectfully pray, therefore, that the present petition be granted in order that they may be heard on the merits of their own case.

3. Petition for Certiorari Raises Question as to Whether "Patentability" and "Obviousness" Are Questions of Law, Questions of Fact or Mixed Questions of Law and Fact From Standpoint of Reversibility of Decisions of Patent Office and District Court

The crux of the question presented here is really whether or not the rule of presumption of correctness which is applied in determining the pure fact question of priority of invention (as in *Morgan* v. *Daniels*) must, *a fortiori,* apply to the questions of law or mixed questions of law and fact as to "patentability" and "obviousness". Respondent, in his Brief in Opposition at pages 5 and 6, contends that the issue of "obviousness" or "patentability" is a question of fact and therefore *Morgan* v. *Daniels,* which dealt with a pure fact question of priority of invention, has been properly extended by the Court of Appeals in *Abbott* v. *Coe,* 109 F. 2d 449; *Esso Standard Oil Company* v. *Sun Oil Company,* 229 F. 2d 37 and *Schafer* v. *Watson,* 228

F. 2d 144, to the law question of *patentability*. Petitioner disagrees.[2]

Only a resolution of the problem by the Supreme Court of the United States will settle the question as to whether the Court of Appeals for the District of Columbia Circuit will be permitted to determine for itself, regardless of the holdings of the Court of Customs and Patent Appeals and other Circuit Courts of Appeals, those findings or conclusions as to which a "presumption of correctness" shall attach and the burden required to overcome any such presumptions. Considering the respective roles of the Courts of the District of Columbia and the Court of Customs and Patent Appeals as Courts of original jurisdiction and an appellate tribunal, respectively, it is imperative that the Supreme Court take a hand in the matter before

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[2] In Mr. Justice Douglas' concurring opinion in *Great A & P Tea Co.* v. *Supermarket Equipment Corp.*, 71 S. Ct. 127; 340 U.S. 147, validity was deemed to be a question of law. Since "patentability" is merely a term used primarily in the process of determining whether a patent *should issue* and the term "validity" is used to express the same concept *after* the patent has issued, there should be no difference between Circuits as to whether "patentability" or "validity" is an issue of law or fact. "Obviousness", on the other hand, is one criterion of "patentability" or "validity" and therefore may be a mixed question of law and fact or, at most, an ultimate fact determined by drawing inferences from the basic facts. Therefore, the "presumption of correctness" of the Trial Court's findings of fact under Rule 52(a), F.R.C.P. and the presumption of correctness of findings of basic facts by the Patent Office does not extend to the ultimate facts, inferences to be drawn from basic facts, conclusions of law or mixed questions as to "obviousness", "patentability" or "validity". A pertinent discussion of the matters as to which a "presumption of correctness" attaches under Rule 52(a) FRCP appears in a relatively recent article in 49 Virginia Law Review 506 (1963).

the situation, which is now utterly confused in the District of Columbia, becomes hopeless.[8]

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[8] The Circuit Courts of Appeals and the Court of Customs and Patent Appeals have generally treated the issue of "patentability" as a question of law or at least one which is to be decided by the Courts. See *Monroe Auto Equipment Co.* v. *Heckethorn Mfg. & Sup. Corp.*, 332 F. 2d 406, 410-412 (CA 6), cert. den. 379 U.S. 888; 85 S. Ct. 160, and cases cited therein, including *In re Sporck*, 301 F. 2d 686, 690-691 (CCPA); and see *National Slug Rejectors* v. *A. B. T. Mfg. Corp.*, 164 F. 2d 333, 336; cert. den. 68 S. Ct. 459, 333 U.S. 832; rehearing den. 68 S. Ct. 658, 333 U.S. 850. The Court of Appeals for the District of Columbia Circuit, however, treats the issue as a *question of fact* in that it applies the "clearly erroneous" rule as a prerequisite to reversal of either the Patent Office or the Trial Court. In *United States* v. *McShain*, 258 F. 2d 422, 103 App. D.C. 328, cert. den. 79 S. Ct. 523, 58 U.S. 832, the Court of Appeals for the District of Columbia Circuit nevertheless held that where the only question before the Court is the interpretation of written documents, "That is a 'question of law' as to which this Court is not bound by the 'clearly erroneous' provision of Federal Rules of Civil Procedure, Rule 52(a)". Since the issue of patentability in cases such as that set forth in the present petition is resolved by interpretation of a written document in the nature of an issued patent or an application filed in the Patent Office, the Court of Appeals is being inconsistent with the rule laid down in *U. S.* v. *McShain*, supra, in applying the "clearly erroneous" rule to patentability cases, particularly where additional documentary evidence as well as oral testimony which was not before the Patent Office is before the Trial Court and the Appellate Court. If the Court of Customs and Patent Appeals, solely on the basis of a printed record, is not bound by the "clearly erroneous" rule, there is no reason why the Court of Appeals for the District of Columbia or the District Court, in a trial *de novo*, should be bound by any such rule or presumption. This conflict between the Court of Customs and Patent Appeals and the Court of Appeals for the District of Columbia Circuit should be resolved by granting the present petition and reversing the Court of Appeals on its application of the "clearly erroneous" rule to this case since it is a denial of due process for the Court of Appeals to apply a rule which is contrary not only to the rule applied in courts of parallel jurisdiction but even contrary to its own application of the rule and the rule laid down by the Supreme Court in *Great A & P Tea Co.* v. *Supermarket*, supra.

4. Petitioners Have Not Retreated From Position Regarding Availability of "Abandoned Applications" as References

Respondent asserts that petitioners "conceded that certain disclosures brought forward in the Hoppe patent as a continuation-in-part of an abandoned 1952 application were a proper reference" (Brief for Respondent, pages 3-4).[4]

Petitioners take the position that September 26, 1956, *the date of issue* of the Hoppe et al. patent, was the first time the public could have known of the existence of the "abandoned application" and therefore the "abandoned application" referred to therein did not become "available" to those skilled in the art and therefore did not become a part of the "prior art" *until that date.* That does not constitute a concession that the "abandoned application" was *known* or was a part of the "prior art" *retroactively* to its own filing date. It would be available as a reference to show "prior invention" as of its own filing date *only if it disclosed the invention claimed by petitioners.*[5]

At the time of trial, the Solicitor for the Patent Office argued in support of the Board's contention (JA 331) that petitioners' invention was *inherent* in the disclosure of the "abandoned application". However,

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[4] Even in Hazeltine (No. 57) and Foster (No. 347) there is no argument that a reference *which discloses the claimed invention* would not be proper evidence of "prior invention" if it *antedates* the date *the same invention was made* by the petitioners.

[5] Concession, or even stipulation by counsel as to the "legal effect of admitted facts" is not binding on the Court, in any event. *Swift & Co.* v. *Hocking Valley RR. Co.*, 243 U.S. 281, 37 S. Ct. 287. (cf. 92 ALR 663) This is particularly true where it is not necessary to examine or appraise the evidence itself to decide the question of law even though the question was never raised before. *Kiefer Stewart Co.* v. *Joseph E. Seagram & Sons*, 340 U.S. 211; 71 S. Ct. 259.

the Trial Court held that petitioners' invention was *not* disclosed in the "abandoned application" (JA 14). Thus, petitioners' concession as to admissibility of the "abandoned application" was limited to its use to show "prior invention" under Section 102 (if it did, in fact, establish that the invention claimed by petitioners was disclosed therein) but not as evidence of what was the "prior art" under Section 103 when petitioners filed their application *long prior* to September 26, 1956.

It would have been an exercise in futility to urge in the District Court that Judge Jackson, sitting as a District Judge, should overrule himself, sitting as a Judge and speaking for the Court of Customs and Patent Appeals *In re Heritage,* 182 F. 2d 639, where he announced the rule that "any reference to a disclosure which is available to the public is permissible". In that case, however, the abandoned application was "available to the public" *at the time the applicant-appellant filed his application* and he was presumed to have been aware of the contents of the "abandoned application" as "prior art" since it was referred to in a patent that issued *before the applicant made his invention or filed his application.*

5. Issue of Due Process Raised by Petitioners in Appellate Court

It is petitioners' position that they cannot be said to have waived the right to raise and argue any and all issues of law or mixed issues of law and fact at any stage of the trial or along the appellate route, even to the doorstep of the Supreme Court of the United States.

The issue of due process was raised before the Court of Appeals, and thoroughly briefed and argued there,

contrary to the assertion of respondent's counsel that that issue is raised for the first time in the present petition. Indeed, the appellate court is the first place the issue could properly have been raised since it was not until the District Court decided the case that it became apparent that due process had been denied petitioners. Moreover, it is the Circuit Court that laid down the rule, followed by the District Court, which resulted in the denial of due process. Only the appellate court had the power to overrule itself on this issue. This it refused to do, tenaciously adhering to its own precedents of *Abbott* v. *Coe, supra; Esso* v. *Sun Oil, supra; Shafer* v. *Watson, supra;* and *Standard Oil* v. *Marzall, 86 App. D. C. 210, 181 F. 2d 280.* (Petitioners' Brief, Appendix 20a).

6. Importance of First Question Presented in Present Petition Not Disputed by Respondent

The Brief for Respondent does not deny that the first question presented in this petition (Petition, page 2) is an important question which is present in every case which arises under 35 U.S.C. 145. That question is whether the District Court for the District of Columbia and the Court of Appeals for the District of Columbia Circuit are affording due process and applying the proper criteria in adjudging whether or not an applicant "is entitled to receive a patent" under 35 U.S.C. 145 where the applicant puts in evidence of unobviousness which was not before the Patent Office and no evidence is offered by the Patent Office other than its previously stated self-serving opinion as to "obviousness" under 35 U.S.C. 103. It includes the question of whether the courts accord *finality* to a mere presumption, notwithstanding the presence of new and additional evidence which was before the Trial

Court but was not before the Patent Office when it refused to issue a patent.

Since the Court of Appeals for the District of Columbia Circuit and the Court of Customs and Patent Appeals are the Courts of last resort and the only Courts in the country to which recourse lies under 35 U.S.C. 141 to 145, inclusive, from the refusal of the Patent Office to issue a patent to an applicant, it is important that the Supreme Court of the United States lay down the proper criteria for them to follow. *Morgan* v. *Daniels,* 153 U.S. 120, the last and only pronouncement of this Court on any issue remotely related to that posed herein was rendered before the Court of Customs and Patent Appeals was given jurisdiction over direct appeals from the Patent Office and was based on a procedural routine which is no longer provided by law.*

Morgan v. *Daniels* concerned an adversary proceeding between private parties, not one between an applicant for patent and the Commissioner. Consistent with the past actions of the Supreme Court in carefully scrutinizing the denial of due process by government agencies and the courts in which the government and a private party are the litigants, petitioners respectfully submit that the Supreme Court should take jurisdiction of the present case.

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* In the first place, *Morgan* v. *Daniels* involved a determination, as between rival claimants, as to which was entitled to receive a patent. This involved determination of basic facts, not a conclusion of law or mixed question of law and fact. In the second place, the procedure allowed there was a direct appeal to the appellate court and a *subsequent* trial de novo in the District Court (and ensuing appeal to the same appellate court) if either party was dissatisfied with the outcome of the appeal.

The second question presented herein is obviously current and important due to the fact that *each and every patent or trademark case* filed against the Commissioner of Patents in the United States District Court for the District of Columbia under 35 U.S.C. 145 and 15 U.S.C. 1071(b), respectively, inherently involves the question presented here. The number of such cases is so large that a single Judge (Hon. Joseph R. Jackson, Senior Judge, formerly a Judge of the Court of Customs and Patent Appeals) has been assigned to hear these cases and substantially all of his time is devoted to the trial and decision of these actions.

Considering also the fact that respondent (Brief for Respondent, page 6) takes issue with petitioners' contention that the Court of Customs and Patent Appeals applies a different standard in affirming or reversing the Patent Office in its refusal to issue a patent, and considering further the fact that the Court of Customs and Patent Appeals and the Circuit Courts of Appeals look to each other for precedents on common issues of law and mixed issues of law and fact, it is important that the Supreme Court review the actions of those courts and bring their views into harmony.[7]

Petitioners respectfully submit that, outside the issues in the patent cases in which the Supreme Court has already granted certiorari, there is no more important issue of patent and trademark law from the standpoint of the public, the courts, the government,

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[7] Perhaps the tendency for the Court of Customs and Patent Appeals to attach no presumption of correctness to rulings of the Patent Office stems from the fact that until *Lurk* v. *United States*, 370 U.S. 530; 82 S.Ct. 1459 and the passage of the *Act of August 25, 1958*, 72 Stat. 848, that Court considered itself a Legislative Court and therefore was part of the administrative rather than the judicial apparatus of the government.

patent and trademark applicants and the bar than the question presented here. Unless recourse is had to the Supreme Court to guarantee a fair trial through the application of proper and reasonable criteria by the inferior courts, patent and trademark applicants are apt to lose confidence in the judiciary as well as the executive branch and thereby weaken the patent and trademark system.

7. Conclusion

Lest the thrust of petitioners' plea be obscured by the length of the present reply, suffice it to say that petitioners pray that their petition be granted since it presents:

1) An important question of judical administration and due process which has neither been considered or decided by this Court since the jurisdiction of direct appeals from the Patent Office under 35 U.S.C. 141 to 144, inclusive, (and its Predecessor Sections 4911-4914 of the Revised Statutes) has been conferred on the Court of Customs and Patent Appeals (or, for that matter, since the Court spoke on a similar issue in *Morgan* v. *Daniels* in 1894 when different procedures and remedies applied);

and

2) An important question as to what constitutes available "prior art", as of the date an invention is made, as the term "prior art" is used in 35 U.S.C. 103. The importance of this question is reflected in the fact that one petition has been granted (Hazeltine, No. 57) and still another petition besides the present one is pending (Foster No. 347), and in the latter case the Court of Cus-

toms and Patent Appeals overruled itself (*In re Palmquist, 319 F. 2d 547*), one Judge dissenting in the latest ruling.

Wherefore, petitioners pray that the present petition be granted as to both questions presented.

Respectfully,

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